

REMARKS

This response is submitted to the Office Action mailed October 5, 2006. At present, all of claims 1 and 3-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Marsh et al. in view of Friedman et al. For one or more of the following reasons, Applicants submit that the claimed invention is patentably distinct from Marsh and Friedman, either alone or in combination.

Claims 1, 3, 5, 7 and 9 have been amended. Support for the amendment to Claim 1 is found at least in ¶¶ 0018, 0019 and 0022. Support for the amendment to Claim 3 is found at least in ¶ 0020. Support for the amendment to Claims 5, 7 and 9 is found at least in ¶ 0018.

It is respectfully requested that the Examiner, upon further consideration of the claims rejected under 35 U.S.C. § 103(a), keep in mind that the proper application of the obviousness test of 35 U.S.C. § 103(a) requires one to picture the person of ordinary skill in the art as having the references before him without any knowledge of applicants' invention. If the references themselves do not suggest the desirability of modifications necessary to achieve an anticipation of a claim, they do not render the claimed subject matter obvious in the sense of 35 U.S.C. § 103. The necessity of avoiding hindsight reconstruction was well stated by the Court of Customs and Patent Appeals in the case of *In re Rothermel and Waddell*, 125 USPQ 323 at 331 (1960), wherein the court noted:

The examiner and the Board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in light of appellant's disclosure...It is easy now to attribute to this prior art the knowledge that was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill of the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of claims, it is not the type of rejection which the statute authorizes. 35 U.S.C. 103 is very specific in requiring that rejection on the grounds the invention would have been obvious must be based on a comparison between the prior art and the subject matter as a whole at the time the invention was made.

This requirement for a detached viewing of the teachings and suggestions of the references necessitates that Examiners study the references and determine what their teachings would be to a person who has not read applicants' application or read their claims. If the

references are considered in the foregoing manner, it is most respectfully submitted that they do not provide a proper anticipation of the rejected claims under § 103.

The Office Action provides the following reason for combining Marsh and Friedman: "...to allow an automated reconciliation, payment and accounting system for use by large scale telecommunications consumers for auditing and managing bills from their communications vendors." However, the claimed invention provides automated reconciliation, payment and accounting of telecommunication bills and may be used by large scale telecommunications consumers. As such, Applicants respectfully submit that the Office Action essentially asserts that the justification to combine Marsh and Friedman is to arrive at the claimed invention. The Office Action does not provide a reason for modifying the references cited by the Office Action in the manner suggested by the Office Action except to arrive at Applicants' specifically defined construction, taught only by Applicants' disclosure.

The combination of references cited quite simply does not expressly or impliedly suggest the claimed invention, and the Office Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. The only reason offered for combining the references is to arrive at the Applicants' claimed invention by hindsight. Applicants respectfully submit that this hindsight reconstruction of the references is impermissible.

In addition to and alternatively to the foregoing, Applicant believes there is convincing objective indicia of nonobviousness of the present invention. Attached is the Declaration of one of the inventors, Kae Kimberly Zulager. As described in that Declaration, a commercial embodiment of the claimed system has enjoyed outstanding commercial success.

Further, even if Marsh and Friedman could be properly combined, neither Marsh nor Friedman teach or suggest all elements of amended Claim 1. Marsh discloses the comparison of actual subscriber usage to telecommunications service provider rate plans in order to select a plan (see Col. 2, lines 5-22). Friedman discloses the comparison of "what was billed [from a telecommunications service provider] versus what should have been billed," also based on actual subscriber usage (¶ 0071). In contrast, amended Claim 1 analyzes and selects a plan based on subscriber predicted usage requirements and historical usage. In contrast to the claimed

invention, Marsh does not teach or suggest the use of subscriber's predicted usage requirements to select a carrier plan. Friedman does not teach or suggest the selection of a carrier plan at all.

Additionally, amended Claim 1 compares the actual usage to the predicted usage requirements, identifies differences, and identifies instances in which such differences result in additional charges to the subscriber. Neither Marsh nor Friedman teaches or suggests the comparison of actual usage and predicted usage requirements. Neither Marsh nor Friedman teaches or suggests the identification of differences between actual usage and predicted usage requirements. And neither Marsh nor Friedman teaches or suggests the identification of instances in which differences between actual usage and predicted usage requirements result in additional charges.

For any one or more of the foregoing reasons, Applicants therefore submit that any combination of the cited references fails to teach or suggest a method for managing telecommunication bills according to amended independent Claim 1. As such, the rejection of independent Claim 1 is therefore overcome. Since Claims 3-9 depend from independent Claim 1, these dependent claims are also patentably distinct from the combination of Marsh and Friedman for at least the reasons described above. The dependent claims include additional recitations that provide additional distinctions relative to the cited references.

For example, amended dependent Claim 5 recites comparing both the selected carrier plan and a new carrier plan to the subscriber's predicted usage requirements, historical usage, and actual usage. Neither Marsh nor Friedman teach or suggest such a multi-faceted comparison. Therefore, amended Claim 5 is patentably distinct from the cited references.

Claims 10-12 have been added. Support for these claims is found at least in ¶ 0018.



CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that all of the claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 50-2127.

Respectfully Submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the appropriate address at the U.S. Patent and Trademark Office required under 37 C.F.R. §1.1(a) on April 3, 2007.

by:

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